REMARKS/ARGUMENTS

Prior to this Amendment, claims 1-7, 9-12, 14-38, and 40-46 were pending and subject to examination on the merits. In this Amendment, claims 1-7, 9-12, 14-19, 30-38, and 40-46 are canceled, and claims 47-58 are added so that claims 20-29 and 47-58 are pending and subject to examination. Claims 20-29 are not amended in this Amendment and are not subject to a new search and/or new consideration.

On November 10, 2005, an interview occurred between the undersigned and Examiner St. Cyr. The undersigned thanks the Examiner for his careful consideration of the arguments made during the interview.

35 USC 103 - Ogasawara and Fernan et al.

In the Office Action, claims 1, 2-6, 9-15, 17, 19, 30, 31, 34-37, 39, and 46 are rejected under 35 U.S.C. 103 as being obvious over Ogasawara (U.S. Patent No. 6,123,259) and Fernan et al. (U.S. Published Patent Application No. 2002/0059584). The rejections based on Ogasawara and Fernan et al. are traversed.

However, to expedite the prosecution of the application, the rejected claims are canceled. As explained below, Applicants still believe that the combination of Ogasawara and Fernan et al. is improper and reserve the right to file a continuation application directed to the canceled subject matter.

35 USC 103 - Ogasawara, Fernan et al. and Johnsen

In the Office Action, claims 5, 8, 16, 18, 20-29, 32, 38, and 40-44 are rejected as being obvious over Ogasawara, Fernan et al., and Johnsen. This rejection is traversed.

Claims 5, 8, 16, 18, 32, 38, and 40-44 are canceled so that only claims 20-29 would still be subject to rejection in this rejection. Independent claim 20 and dependent claims 21-29 are not obvious in view of Ogasawara, Fernan et al., and Johnsen.

1.   *Independent claim 20 is not obvious, because neither Ogawarawa, Fernan et al.,
            nor Johnsen teach or suggest retrieving or sending a data string including a
            wildcard value from a portable consumer device to a card access device.*

Independent claim 20 is not obvious, because all limitations in independent claim
20 are not taught or suggested by the cited art. To establish *prima facie* obviousness of a
claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re
Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP 2143.03. Here, neither Ogasawara,
Ferman et al., nor Johnsen teach or suggest, a method comprising *inter alia*, "retrieving the first
data string [including one or more wildcard values] using a card access device" as recited in
independent claim 20, "retrieving a first data string comprising one or more wildcard values from
a portable consumer device comprising a computer readable medium comprising the first data
string including one or more wildcard values, using a card access device" as recited in
independent claim 47, or a method "wherein [a] first data string is ... sent from [a] portable
consumer device to a card access device" as recited in independent claim 53.

The Office Action admits that Ogasawara and Johnson do not teach "wildcards" at
all. Rather, the Office Action relies on Ferman et al. to teach "wildcards". Paragraph [0329] is
the only paragraph in the 617 paragraphs in Ferman et al. that mentions "wildcards". It is recited
below:

> [0329] The Location field may include various wildcards to
> expand or restrict the target paths to be evaluated in the Program
> Description. For example, a "*" wildcard implies that there may be
> multiple instances of the given location under one parent, e.g.,
> /Creation/*Creator implies that there may be multiple Creators
> under the Creation parent. A "#xxx" wildcard restricts the target
> path to the xxx instance of the given location under its parent, e.g.,
> /Creation/#002Creator restricts the target path to the second
> instance of Creator under Creation. A double forward slash "//"
> indicates a node of the target path which may be used as a base
> path for groups of tests which must be constrained to evaluate from
> the same common location. In particular, this is useful for
> Constrained-AND operations, described later. The preference paths
> may be used to build target locations in the program. These

preference paths may also allow preference paths to be interpreted as locations. Composite values may be defined for these preference path locations.

As noted above, Fernan et al. uses wildcards in a "Location field" to "expand or restrict the target paths to be evaluated in [a] Program Description". Thus, it appears that Fernan et al. describes wildcards as a means for accessing data in different ways. It is not even clear that the "Location field" is even in a portable consumer device in Fernan et al. Even assuming, arguendo, that the Location field and the wildcard is in a portable consumer device, there is no teaching or suggestion in Fernan et al. to "retrieve" or "send" a data string with one or more wildcard values from the Location field to any other location, let alone a card access device. The wildcards disclosed in Fernan et al. appear to be specifically designed to be used only in the Location field and nowhere else. Since the cited prior art does not teach or suggest each and every limitation of independent claims 20, 47, and 53, obviousness has not been established.

2.   *Independent claim 20 is not obvious, because the alleged motivation to combine Ogasawara and Fernan et al. came from Applicants' own disclosure and not the prior art as required by 35 U.S.C. § 103.*

Independent claim 20 is also not obvious, because the alleged motivation to combine Ogasawara and Fernan et al. came from Applicants' own disclosure and not the prior art as required by 35 U.S.C. § 103. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). According to the MPEP § 2142 and the CAFC:

> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, the Examiner acknowledges that Ogasawara does not teach "wildcards", but relies of Fernan et al. to supplement Ogasawara. The Examiner states:

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In view of Fernan et al.'s teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Ogasawara to include wildcard values representing customer's preference information. Such modification would expand the storage of the card, which would provide means for storing additional information about the customers, furthermore, these storage schemes, such as object oriented databases, are very common in the art for storing information. Therefore, it would have been an obvious extension as taught by Ogasawara.

While the Examiner alleges that one would have been motivated to have modified Ogasawara to use wildcard values to "expand the storage of the card", Fernan et al., the only reference that mentions "wildcards", does not use a wildcard value to "expand the storage of a card". As noted above, paragraph [0329] indicates that Fernan et al. uses wildcard values to "expand or restrict target paths". Contrary to the Examiner's assertion, the use of Fernan et al.'s wildcard values has nothing to do with "expanding the storage of a card". Accordingly, the prior art does not suggest that wildcard values can be used to expand the storage of a card. The rejection should be withdrawn for this reason alone.

The Examiner also states that wildcards are used in "object oriented databases, [and they] are very common in the art for storing information." This allegation has been made without the citation of a supporting prior art reference. To the extent that the Examiner is taking "official notice" that data strings with "wildcards" are "well known in the art", Applicants challenge the taking of any official notice on this point and request that a prior art reference be cited for each and every instance where allegations are made that limitations in the claims are "well known". If something is "well known", then it should not take long to find and cite such "well known" prior art teachings.

As shown above, the alleged motivation to "expand the storage of the card" is not in the prior art. Rather, the only place of record that mentions the motivation used in the obviousness rejection is Applicants' own specification at paragraph [0030], which states:

[0030] Storing a data string with one or more wildcard values in a portable consumer device has a number of advantages. For

> example, the storage space on a portable consumer device is
> limited due to the portable consumer device's size. In some
> embodiments, the one or more wildcard values stored on a portable
> consumer device may represent a portion of a product
> identification code (rather than the full number) identifying a
> subgroup of products rather than a single product. This reduces the
> data storage requirements in the portable consumer device.

Since it is Applicants' own specification that forms the basis for the Examiner's motivation to combine Ogasawara and Fernan et al., and since the Examiner has not established that the prior art provides the motivation, the obviousness rejection is clearly improper.

3.   *Independent claim 20 is not obvious, because the combination of Ogasawara, Fernan et al., and Johnsen was based on improper hindsight in view of Applicants own specification.*

Independent claim 20 is not obvious, because the combination of Ogasawara, Fernan et al., and Johnsen was based on improper hindsight in view of Applicants own specification. MPEP § 2141.01 discusses improper hindsight and states

> III. CONTENT OF THE PRIOR ART IS DETERMINED AT THE
> TIME THE INVENTION WAS MADE TO AVOID HINDSIGHT
>
> Requirement for "at the time the invention was made" is to avoid
> impermissible hindsight. ...
>
> "It is difficult but necessary that the decisionmaker forget what he
> or she has been taught . . . about the claimed invention and cast the
> mind back to the time the invention was made (often as here many
> years), to occupy the mind of one skilled in the art who is
> presented <u>only</u> with the references, and who is normally guided by
> the then-accepted wisdom in the art." W.L. Gore & Associates,
> Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir.
> 1983), cert. denied, 469 U.S. 851 (1984).

The Court of Appeals for the Federal Circuit has also stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Here, it is clear that the Examiner is improperly "picking and choosing" isolated teachings from the prior art, using Applicant's own specification as a blueprint, to reject the claims.

First, the primary reference, Ogasawara, is entitled "Electronic Shopping System Including Customer Relocation Recognition", while the secondary reference, Fernan et al., is entitled "Audiovisual Management System". Clearly, audiovisual management systems have nothing to do with electronic shopping systems including customer relocation recognition. Ogasawara has no need for an audiovisual management system as disclosed in Fernan et al., and Fernan et al. has no need for an electronic shopping system as disclosed in Ogasawara.

Second, Fernan et al. mentions wildcards in only one paragraph in 617 paragraphs of text. One skilled in the art, viewing only Ogaswara and Fernan et al. would not have picked out the single paragraph that discusses wildcards in 617 paragraphs of text unless they were using improper hindsight after viewing Applicants' disclosure.

Third, as noted above, the only place of record that teaches the motivation in the Office Action is Applicants' own specification. The Office Action has not established that the prior art teaches or suggests the motivation to combine Ogasawara and Fernan et al., and the only place of record that provides the motivation to combine is Applicants' own specification.

In summary, the combination of Ogasawara and Fernan et al. is based on improper hindsight, because (1) Ogasawara and Fernan et al. describe ideas with widely diferent goals and objectives, (2) the Examiner has selected an isolated teaching in one paragraph out of the 617 paragraphs in Fernan et al. to reject the claims, and (3) the motivation to combine was taken from Applicants' own disclosure and not the prior art. The combination of Ogasawara is clearly based on improper hindsight in view of Applicants' own disclosure and not the prior art.

35 USC 103 - Ogasawara, Fernan et al., Johnsen and Allard et al.

Claim 45 is rejected as being obvious in view of Ogasawara, Fernan et al., Johnsen and Allard et al. (U.S. Patent No. 6,249,773). This rejection is traversed.

However, claim 45 canceled to expedite the prosecution. Withdrawal of the rejection is requested.

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CONCLUSION

In conclusion, Applicants respectfully submit that there are ample reasons for

concluding that the present claims are allowable. Accordingly, in view of the foregoing,

Applicants believe all claims now pending in this Application are in condition for allowance.

Respectfully submitted,

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